

REMARKS

On entry of the instant Amendment, Claims 77, 79 and 80 are pending. Claim 77 has been amended to more particularly point out the Applicant's invention.. It is respectfully pointed out that this case was previously allowed. Notwithstanding, this amendment addresses the new issues raised by the new Office Action. The Examiner is also reminded that a Petition to Make Special has been granted for this case. Accordingly, it is respectfully submitted that upon entry of the amendment and consideration of the remarks below, the Application is in condition for allowance.

CLAIM REJECTIONS-35 USC § 112

Claim 77 has been rejected under 35 USC § 112, second paragraph, based upon several antecedent basis problems as set forth in paragraphs 7 and 8 of the Detailed Action. Claim 77 has been amended as suggested by the Examiner. As such, this objection should be overcome. As such, the Examiner is respectfully requested to withdraw this rejection.

CLAIM REJECTIONS-35 USC § 103

Claims 77 and 80 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsieh, U.S. Patent No. 4,923,023 or Pusic, U.S. Patent No. 5,065,000. The Applicant agrees with the assertion by the Examiner that the Hsieh fails to teach printing a bar code and receipt (Official Action, paragraph 12). The Pusic patent was cited for disclosing an "automated electronic postage meter" which includes a printer for printing a bar code and receipt. Paragraph 12 of the Detailed Action states : "It would have been obvious to one of skilled in the art at the

time of the invention to combine the teachings of Pusic with Hsieh so as to allow for quicker delivery with the use of reading a bar code and allowing the user proof of mailing the envelope.”

It is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness. As set forth in § 2143 of the MPEP:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.”

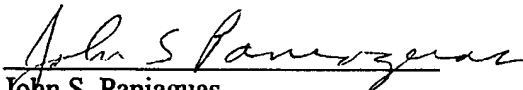
It is respectfully submitted that the rejection of claim 77 does not meet any of the basic criteria. In particular, the combination of the Hsieh or Pusic references do not disclose all of the claim limitations. For example, claim 77 recites a display for displaying the available delivery options and the cost of the selected option. Neither the Hsieh or Pusic patents disclose a system with such a feature. In addition, it is respectfully submitted that there is no suggestion or motivation, either in the references themselves or in the knowledge available to modify the reference or to combine the teachings as suggested by the Examiner or whether there is a reasonable expectation of success of the combination. . As set forth in MPEP § 2143, the motivation or suggestion to combine the references must either be contained in the references themselves or the knowledge generally available to one of ordinary skill in the art. As mentioned above, the Hsieh does not disclose or suggest a printer for printing a receipt or a bar code label for placement on the package by the user . Rather Hsieh teaches a “stamping means 8

" which includes a stamping plate 81 and a stamper 82 that is mechanically driven by a motor of a drive mechanism 30 (Col. 3, 33-39). As set forth in Col. 2, lines 61 et seq of the Hsieh patent, the drive mechanism 30 is also used to drive the conveyor within the machine which transports the letter. It is respectfully submitted that the Examiner has not shown a reasonable expectation of success of the combination which would require various modifications, such as: modification of the transport system to eliminate the mechanical stamper as taught by Hsieh and add a printer for printing a bar code label to be placed on the package *by the user* considering the fact that the system disclosed in Hsieh is a closed system. In particular, as disclosed in Hsieh, the envelope is received in the machine and all processing including the stamping on the envelope is done while the envelope is in the machine. Thus, it is respectfully submitted that not only has the Examiner not shown the required motivation but has also not shown a reasonable expectation of success. For all of the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection.

Claim 79 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsieh, and Pusic and further in view of Tateno US Patent No. 4,836,352. Claim 79 is dependent upon claim 77. The Tateno patent was cited for disclosing a touch screen. It otherwise does not disclose or suggest a system as recited in the claims at issue. In addition, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case. For all the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 79.

Respectfully submitted,

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